

REMARKS

This paper responds to the Final Office Action dated July 15, 2009. No claims are amended herein. Claims 1-14 and 23-34 were previously canceled, and no claims are added. As a result, claims 15-22 remain pending in this application.

§ 102 Rejections of the Claims

Claims 15-22 were rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Spiegel et al. (U.S. Patent No. 6,466,918, hereinafter “Spiegel”). To anticipate a claim, a reference must teach **each and every element** of the claim,¹ as arranged in the claim,² and in as complete detail as in the claim.³ Applicants respectfully submit that the cited reference does not establish a *prima facie* case of anticipation, because the cited reference fails to teach each and every element of Applicants’ claimed subject matter, as arranged in the claims, and in as complete detail as in the claims.⁴

Independent claim 15 recites, in part, “identifying at least one **frequently used search term** associated with the identified division.”⁵ The Final Office Action cited FIG. 1A of Spiegel and “in particular: col. 4, lines 43-67; col. 6, lines 5-60; col. 7, lines 6-67; [and] col. 8, lines 33-59” of Spiegel as allegedly disclosing this limitation.⁶ The entirety of Spiegel, however, actually fails to disclose identifying a frequently used search term, as recited in claim 15.

¹ “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

² It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, **arranged as in the claim.**” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Cornell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983), emphasis added.

³ “The identical invention must be shown in **as complete detail** as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131; emphasis added.

⁴ “[T]he exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983).

⁵ Claim 15, emphasis added.

⁶ Final Office Action, page 4.

The Final Office Action asserted that “the frequently-used search term “Olympics” [is] associated with the second identified division under “Featured Categories” in Figure [1A].”⁷ FIG. 1A of Spiegel, however, appears to depict the phrase “Olympics (75 Bestsellers)” as one of three “Featured Categories” on a web page.⁸ The cited text of Spiegel explicitly states that “FIG. 1A illustrates an example Web page that includes . . . **featured book categories** 110 and featured book titles 120.”⁹ Moreover, “the featured book categories and featured book titles are derived from the Sports & Outdoors branch of the browse tree.”¹⁰ In fact, Spiegel specifically refers to “Olympics” as a “**category**.”¹¹ Therefore, according to Spiegel, the word “Olympics” shown in FIG. 1A of Spiegel is a title of a category that was derived from a branch of a browse tree.

A title of a category is not functionally equivalent to a **search term**, and deriving a category from branch of a browse tree is not functionally equivalent to identifying a frequently used search term. Although column 4, lines 16-24 of Spiegel discusses that “[n]ode popularity levels are . . . determined based on user activity data . . . [that] may include . . . the **number** of searches performed within each category,”¹² a mere number is not functionally equivalent to a search term. Indeed, the phrase “search term” does not appear at all in Spiegel, and Spiegel makes no mention of any functional equivalent thereof. Furthermore, Spiegel contains no discussion whatsoever of **frequency of use** with respect to a search term. As a result, the cited portions of Spiegel do not, and cannot, disclose identifying a **frequently used search term**¹³ associated with an identified division, or any functional equivalent thereof. Because the remainder of Spiegel is silent with respect to this limitation, Spiegel fails to disclose this limitation, as recited in claim 15.

⁷ *Id.* at page 2.

⁸ Spiegel, FIG. 1A, item 110.

⁹ *Id.* at column 7, lines 6-8, emphasis added.

¹⁰ *Id.* at column 7, lines 8-11, internal quotations and references omitted, emphasis added.

¹¹ *Id.* at column 7, lines 12-13, “the **category** “Olympics” is featured . . .,” emphasis added.

¹² *Id.* at column 4, lines 16-24, emphasis added.

¹³ See specification, paragraph 00010, “[t]he phrase “frequently used search term” is intended to include, for example, **terms that are frequently entered by users** when conducting searches for listings,” emphasis added.

Moreover, independent claim 15 recites, in part, “providing a link to the user to **listings associated with the** at least one frequently used **search term**.”¹⁴ The Final Office Action cited “Figure 1” of Spiegel and “in particular, column 4, lines 61-67” of Spiegel as allegedly disclosing this limitation.¹⁵ The entirety of Spiegel, however, in fact fails to disclose providing a link to listings associated with a search term, as recited in claim 15.

The Final Office Action asserted that “the items/listings shown in Figure [1A] are hyperlinks.”¹⁶ As noted above, “FIG. 1A [of Spiegel] illustrates an example Web page that includes . . . featured book categories 110 and featured book titles 120.”¹⁷ Moreover, “[t]he featured books and categories are displayed as respective hyperlinks that provide a direct path to the corresponding books and categories.”¹⁸ Furthermore, the cited text of Spiegel states that “[e]ach node [of the browse tree] is . . . displayed . . . as a hyperlink (see FIG. 1A),”¹⁹ and “[s]election of a node (hyperlink) causes the children of the node to be displayed.”²⁰ Therefore, according to Spiegel, each hyperlink shown in FIG. 1A of Spiegel is simply a link to a corresponding book or category in the browse tree.

Mere discussion of a hyperlink to a “corresponding” book or category fails to disclose a link to **a listing associated with a search term**, or any functional equivalent thereof. Nothing in the cited portions of Spiegel, or in the remainder of Spiegel, provides any mention of a link to a listing associated with a search term, much less a link to a listing associated with a frequently used search term, as recited in claim 15. As a result, Spiegel fails to disclose this limitation.

Because **each and every element** of independent claim 15 is not set forth in the cited reference, as arranged in the claim, and in as complete detail as in the claim, no *prima facie* case of anticipation is established. For at least these reasons, independent claim 15 and its dependent

¹⁴ Claim 15, emphasis added.

¹⁵ Final Office Action, page 3.

¹⁶ *Id.*

¹⁷ Spiegel, column 7, lines 6-8.

¹⁸ *Id.* at column 7, lines 17-19.

¹⁹ *Id.* at column 4, lines 61-62.

²⁰ *Id.* at column 4, lines 64-65.

claims are patentable over the cited reference. Thus, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.


If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15th day of September, 2009.

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